

## REMARKS

Claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 were rejected and remain pending.

In light of the following remarks, Applicants respectfully request reconsideration and allowance of claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38.

### Withdrawn rejections

Applicants acknowledge the withdrawal of the previous obviousness-type double patenting rejections and rejections under 35 U.S.C. § 112, first paragraph.

### Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejected claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, first paragraph as allegedly containing new matter and lacking written description.

Applicants respectfully disagree. Applicants' specification fully supports the previously presented claims. In particular, each independent claim recites a recombinant nucleic acid comprising a nucleotide sequence encoding an autocatalytically cleaving ribozyme and a trans-acting ribozyme. Such nucleic acid sequences are disclosed throughout Applicants' specification. For example, page 13, lines 20-21 and Figure 3 of Applicants' specification disclose a nucleotide sequence encoding autocatalytically cleaving ribozymes and a trans-acting ribozyme. *See, also*, page 10, lines 9-17. In addition, each independent claim recites that the autocatalytically cleaving ribozyme comprises a first arm of complementary sequence and a second arm of complementary sequence, wherein the cleavage site of the autocatalytically cleaving ribozyme is located between the first and second arms. Such a structure is fully disclosed in Applicants' specification. *See, e.g.*, Figure 3. Each independent claim also recites that one of the first and second arms is proximal to the trans-acting ribozyme, and the other of the first and second arms is longer than the corresponding arm of a pCLIP cassette. Such a feature is fully disclosed in Applicants' specification. For example, page 36, lines 4-8 disclose lengthening the arms of cis-acting ribozymes of a pCLIP cassette. Both U.S. Patent Application Serial No. 08/554,369, which issued as U.S. Patent No. 5,824,519, and Figure 2 of the present

application disclose a pCLIP cassette. Thus, taken together, a person having ordinary skill in the art reading Applicants' specification would have appreciated that Applicants' specification fully supports the present claims.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, first paragraph.

Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejected claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite since the term "longer" is a relative term.

Applicants respectfully disagree. The present claims recite that an arm is "longer than the corresponding arm of a pCLIP cassette." A person having ordinary skill in the art reading Applicant's specification would have had no problem understanding what this phrase means. This is particularly true given that (1) the plain and ordinary meaning of the word "longer" is quite easy for a person having ordinary skill in the art to understand, and (2) Figure 2 discloses a pCLIP cassette. Thus, the present claims are not indefinite.

In light of the above, Applicants respectfully request withdrawal of the rejection of claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 under 35 U.S.C. § 112, second paragraph.

Applicant : James S. Norris et al.  
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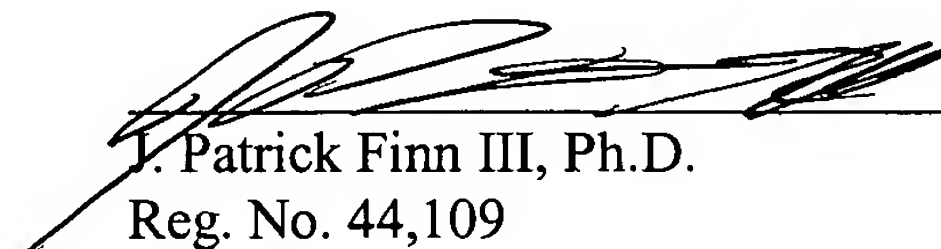
Attorney's Docket No.: 14017-004002 / PSU 96-1566

### CONCLUSION

Applicants submit that claims 1, 4, 5, 7, 10, 12, 17, 19-24, 26, 35, 36, and 38 are in condition for allowance, which action is requested. The Examiner is invited to call the undersigned agent at the telephone number below if such will advance prosecution of this application. The Commissioner is authorized to charge any fees or credit any overpayments to Deposit Account No. 06-1050.

Respectfully submitted,

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